

REMARKS

Claims 1-60 are pending. Claims 1-16 have been amended herein.

I. RESTRICTION REQUIREMENT

The Examiner has issued a restriction requirement grouping the pending claims as follows:

Group I: Claims 1-16, 18, 19, 21-29, 31-33 and 42-60.

Group II: Claims 20 and 34-41.

In sustaining the restriction requirement, the Examiner states that Group I is drawn to a flux-guided magnetoresistive head, Group II is drawn to details of the read circuitry, and claims 17 and 30 are linking claims.

Applicant provisionally elects Group I but traverses the restriction requirement for the following reasons.

First, the Examiner has failed to indicate which Group includes claims 17 and 30.

Second, claims 17-60 are explicitly directed to a magnetic storage device. For instance, independent claim 17 recites "A magnetic storage device" that includes "magnetic media," "a head" and "circuitry adapted to receive a readback pulse." Similarly, independent claim 30 recites "A magnetic storage device" that includes "magnetic storage media," "a head" and "circuitry adapted for receiving readback pulses." Claims 18-29 depend (directly or indirectly) on claim 17, and claims 31-60 depend (directly or indirectly) on claim 30. Therefore, the Examiner's position that Group I claims 18, 19, 21-29, 31-33 and 42-60 are drawn to a flux-guided magnetoresistive head is clearly incorrect.

Third, claim 1 has been amended to recite "A magnetic recording system" that includes "a head," "magnetic media" and "circuitry adapted to receive a readback pulse." Claims 2-16

depend (directly or indirectly) on claim 1. Therefore, claims 1-16 are now directed to a magnetic recording system instead of a head.

Fourth, the fact that various dependent claims recite additional features of the circuitry does not justify a restriction requirement. Obviously a claim which does not recite these features “does not require the specifics of the circuitry recited in Group II.” However, this circular reasoning does not explain why the dependent claims which recite these features have “separate utility” or are “separately usable” from the claims upon which they depend.

Fifth, MPEP § 806.05(d) states that “Care should always be exercised in this situation to determine if the several subcombinations are generically claimed.” As mentioned above, the dependent claims which recite further features of the circuitry depend from generic claims directed to a “magnetic recording system” or a “magnetic storage device.” These generic claims also recite a “head” and “magnetic media” (or “magnetic storage media”). There are no claims directed solely to the circuitry. Thus, the so-called subcombinations are generically claimed.

Accordingly, Applicant respectfully requests that the restriction requirement be withdrawn.

II. TITLE

The Title has been amended to more closely comport with the claims.

III. CORRESPONDENCE ADDRESS

Applicant filed a Change of Correspondence Address (copy attached) with the previous Response. However, the outstanding Office Action was sent to the previous correspondence address. Applicant respectfully requests that future correspondence be sent to the new correspondence address.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231,

On Nov 9, 1999.

D Sigmond

David M. Sigmond
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11/8/99

Date of Signature

Respectfully submitted,

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